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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/857,677
Filing Date: October 16, 2001
Appellant(s): HASEMANN, JOERG-MICHAEL

Jong H. Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/08/2006 appealing from the Office action mailed 02/23/2005

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

Amended figures 1-6 containing descriptive label after final has been filed. The amendment figures 1-6 has been entered on 08/08/2005.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,487,421	Hess et al	11-2002
6,081,261	Wolff et al	06-2000
4,751,741	Mochinaga et al	06-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 27, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess (US 6,487,421) in view of Wolff (US 6,081,261) and in further view of Mochinaga et al (US 4,751,741).

As to claim 12, Hess teaches a telecommunication terminal, comprising: a plurality of data input units (see fig. 1, number 7; microphone, number 14, operating element), a character recognition unit (see fig. 3, number 58; col. 3, lines 12-16). Hess

fails to teach a plurality of data input units including at least one pressure sensor element; a pressure receiving element acting jointly with the at least one pressure sensor element so that a movement of the pressure receiving element on a surface is detectable by the at least one pressure sensor element, the movement of the pressure receiving element detected by the at least one pressure sensor element is being converted into signaling information by the character recognition unit in the single integrated housing, and the surface is able to be written upon by the movement of the pressure receiving element. Wolff teaches data input unit including one pressure sensor element (see fig. 8, number 100, col. 7, lines 46-54), a pressure receiving element acting jointly with the at least one pressure sensor element so that a movement of the pressure receiving element on a surface is detectable by the at least one pressure sensor element (see fig. 8, number 114, col. 3, lines 57-67), wherein the movement of the pressure receiving element detected by the at least one pressure sensor element is convertible into signaling information by the character recognition unit (see col. 9, lines 39-57), and the surface is able to be written upon by the movement of the pressure receiving element (see fig. 6, number 116, col.7, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wolff into the device of Hess for recognizing when a written entry is made on a page.

The combination of Hess and Wolff fails to teach the character recognition unit and the pressure receiving unit wherein the movement of the pressure receiving element detected by the at least one pressure sensor element is being converted into

signaling information by the character recognition unit in the single integrated housing, the plurality of data input units include a plurality of confirmation devices and signaling information is correctable by the plurality of confirmation devices. Mochinaga teaches the character recognition unit and the pressure receiving unit wherein the movement of the pressure receiving element detected by the at least one pressure sensor element is being converted into signaling information by the character recognition unit in the single integrated housing (see fig. 1, 3a, 3b, col. 2, lines 66-67, col. 3, lines 1-27), a confirmation device and signaling information is correctable by confirmation device (see fig. 1, number 8, col. 3, lines 17-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mochinaga into the device of Hess and Wolff so that the input signals can be corrected by the users. The combination of Hess, Wolff and Mochinaga discloses one confirmation device 8 instead of plurality of confirmation devices. However, it would have been obvious to one of ordinary skill in the art to replace a confirmation device 8 with plurality of confirmation devices 8 in the above combination because input signals could be quickly corrected.

As to claim 13, Hess teaches the telecommunication terminal, wherein the character recognition unit recognizes alphanumeric characters (see fig. 3, number 58, col. 6, lines 64-66).

As to claim 14, Hess teaches the telecommunication terminal, further comprising: a transmitting unit via which a signal can be dispatched in dependence on the signaling information (see fig. 3, number 56, see col. 7, line 6).

As to claims 15, 16, Hess further teaches a reproduction device (see Hess fig. 1, number 5, number 6, see col. 5, lines 1-8);

As to claim 17, the modified Hess fails to teach the telecommunication terminal, wherein the signal information is representable by the reproduction devices with at least one of an optical form and acoustic form. However, Wolff teaches the telecommunication terminal, wherein the signal information is representable by the reproduction devices with at least one of an optical form and acoustic form (see col.4, lines 28-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wolff into the modified Hess in order to validate handwritten information.

As to claim 18, the combination of Hess, Wolff and Mochinaga teaches the telecommunication device, wherein Wolff further teaches that the pressure receiving element includes a writing tip (see fig. 8, number 116, col. 7, lines 57-59).

As to claim 19, Hess further teaches an input function and operating function can be activated in dependence of signal information according to menu driven operation (see fig. 1, number 9, col. 3, col. 5, line 4).

As to claims 20, 23 Hess inherently teaches radio mode can be activated and operated (see fig. 1, number 8, col. 5, line 4).

As to claims 21,22, Hess further teaches the telecommunication device, wherein the radio mode is for at least one of a voice communication (see fig. 3, number 44. col. 7, lines 10-18) and for exchange of brief messages; sms messages (see col. 7, lines 24-37).

As to claims 24, 25, Hess further teaches memory mode can be activated and operated for entering at least one telephone and station name entry into the memory (see col. 7, lines 38-44).

As to claim 27, the combination of Hess, Wolff teaches the telecommunication terminal wherein Wolff further teaches an alarm clock mode can be activated and operated (see col. 4, lines 30-31).

As to claim 28, Hess further teaches data interface for transmitting data (see fig. 3, number 49, col. 6, line 67, col. 7, lines 1-4).

As to claim 29, Hess further teaches infrared interface (see col. 4, lines 12-13)

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hess (US 6,487421) in view of Wolff (US 6,081,261), Mochinaga et al (US 4,751,741) as applied to claim 15 above and further in view of Nagai (US 6,104,388).

As to claim 26, the combination of Hess, Wolff and Mochinaga fails to teach the telecommunication terminal wherein a calculator mode can be activated and operated, and the signaling information is processable and calculation results are displayable in accordance with an operation of the plurality of reproduction device. However, Nagai teaches the telecommunication terminal wherein a calculator mode can be activated and operated, and the signaling information is processable and calculation results are displayable in accordance with an operation of the plurality of reproduction device (see col. 6, lines 17-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nagai into the device

of Hess, Wolff and Mochinaga in order to detect and recognize handwritten information (see col. 1, lines 5-10 as suggested by Nagai).

(10) Response to Argument

1. In response to the argument of claim 12, the appellant argues that the applied prior art does not provide any motivation or rational for combining the elements in the manner contemplated by claim 12. The examiner disagrees. Hess et al teaches a pen-shaped terminal which includes a motion detector containing two or more acceleration sensors in order to measure acceleration of the point of the terminal and these signals are transmitted to electronic circuit if the terminal is placed on a surface, the operation element is pushed inward and there applies a load to switch (acting to some extent as a pressure sensor element) so that it transmitted a identification signals to the electronic circuit (see col. 4, lines 59-67, col. 5, lines 1-40) and the recognition device receives signals from the switch (see col. 5, lines 41-57); Wolff discloses to some extent the same elements shown by Hess. Specially, a pen-like device included data input entry unit including one pressure sensor element (see fig. 8, number 100, col. 7, lines 46-54), a pressure receiving element acting jointly with at least one pressure sensor element so that a movement of pressure receiving element on the surface is detected by at least one pressure sensor element (see fig. 6, numbers 116, 114, col. 3, lines 57-67) wherein the movement of the pressure receiving elements is converted into signal information by the character recognition unit (see col. 9, lines 39-57); Mochinaga also contains elements very similar to Hess and Wolff. Specially, Mochinaga teaches a pen-type character recognition includes the character recognition unit and the pressure receiving

unit where the movement of the pressure unit detected by at least one pressure sensor element is converted into signal information by character recognition unit (see fig. 1, numbers 2, 3a, 3b, col. 2, lines 66-67, col. 3, lines 1-27) and signal information is correctable by the confirmation device (see fig. 1, number 8, col. 3, lines 17-27). Therefore, all references (Hess; Wolff and Mochinaga) teach the pen-like device that includes entry data input unit with one pressure sensor elements, a pressure receiving element acting jointly with the pressure sensor element so that the movement of pressure receiving element is detected by the pressure sensor element. The Wolff and Mochinaga references were merely applied to modify the elements already present within the Hess reference, thereby leading one of ordinary skill in art motivated to combine the teachings of Wolff and Mochinaga.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves. Wolff et al teaches the pressure sensor element information is useful for recognizing when written on the CB page and for parsing the entry into message units for message recognition and for

signature recognition (see col. 8, lines 64-67). Therefore, one of the skill in the art would look to the Wolff reference in order to improve the pressure sensing element of Hess. Mochinaga et al teaches that the input characters can be recognized and easily corrected without requiring the re-inputting of the character when the correction is depressed (see col. 11, lines 41-51). Likewise, one of ordinary skill in the art would look to the Mochinaga reference to easily correct characters input to the terminal.

3. In addition, the appellant argues that the applied references are non-analogous art describing Hess as a mobile radio telephone and Wolff as a pen-like instrument. The examiner disagrees. In response to applicant's argument that Hess, Wolff and Mochinaga are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the terminal of Hess is, in combination, a mobile terminal and character recognition terminal; a character recognition terminal very similar to applicant's claim invention. And since both the Wolff and Mochinaga reference deal with same environment (as described earlier), it is still believed that these references are from analogous art.

4. Appellant argues the combination of Wolff and Mochinaga with Hess would completely change the operation of Hess since the switch device and the motion sensor satisfies the need of Hess system. The examiner disagrees. Hess teaches a terminal with a switch device and a motion sensor wherein the motion sensor measures the

accelerations of the point area of the terminal when the terminal is placed on a surface (see col. 5, lines 24-52) which is the same teaching of Wolff (see col. 7, lines 46-67) and Mochinaga (see col. 3, lines 7-14) wherein the sensor measures the force applied to the tip of the pen-like device. In other word, all 3 references operate with one purpose using a pen-like instrument to sense and recognize characters. Therefore, the combination of Wolff and Mochinaga with Hess would not change the operation of Hess.

5. Lastly, the appellant also argues that the asserted combination is based on impermissible hindsight. The examiner disagrees. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the applied prior art all teaches the same field of invention i.e. pen-like instrument which includes data input unit with a pressure receiving element (see Hess col. 4, lines 59-67, col. 5, lines 1-40, Wolff fig. 6, numbers 116, 114, col. 3, lines 57-67, Mochinaga fig. 1, numbers 2, 3a, 3b, col. 2, lines 66-67, col. 3, lines 1-27), one pressure sensor element wherein a pressure receiving element acting jointly with the at least one pressure sensor element so that a movement of the pressure receiving element on a surface is detectable by the at least one pressure sensor element, wherein the movement of the pressure receiving element

detected by the at least one pressure sensor element is convertible into signaling information by the character recognition unit (see Hess col. 5, lines 41-57, Wolff fig. 8, number 100, col. 7, lines 46-54, col. 9, lines 39-57, Mochinaga fig. 1, number 8, col. 3, lines 17-27). Therefore, the combination of Hess, Wolff and Mochinaga is not based on hindsight reconstruction since all references disclose pen-like instrument to sense and recognize character based on the pressure sensor element.

Regarding claim 26, the same argument is applied as to claim 12 above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted ,

Nhan Le

09/26/06.

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